

REMARKS

A. Entry Of Applicant's Earlier Filed Amendment

The entry of Applicant's earlier filed amendment of claim 8 to overcome the objection set forth in paragraph 5 on page 2 of the Office action, is noted with appreciation.

B. Rejection Of Claims 1-19 Under 35 U.S.C. §102(b) Over Pond et al. '690

Claims 1 through 19 were rejected under 35 U.S.C. §102(b) as being anticipated by Pond *et al.* (US 5,886,690). Applicant respectfully traverses this rejection because the rejection is untenable. Specifically, the Examining staff has premised this rejection upon a prior art reference which is non-enabling for both the purposes asserted by the Examining staff and for the limitations asserted in the claims of that reference, the Examining staff has inaccurately characterized the teachings of Pond '690 and has not given consideration to "the invention" as is mandated by 35 U.S.C. §102(b). Moreover, Paper No. 20050329 is incomplete under 37 CFR §1.104(a)(b) and (c).

1. Pond '609 Fails To Provide A Written Description And Fails To Describe How To Make And Use The Structure Asserted By The Examining Staff

In support of this rejection, Paper No. 20050329 states that Pond '609 teaches:

(i) "in column 5, lines 22-40, column 6, lines 3-10, in column 7, lines 21-28, and figures 2 and 5, a **control unit for inputting commands to display a sub-list having a predetermined number of channels (files) with associated programs (files), from the set of all channels (files), the sub-list created from downloading, to memory storage hardware, a list of available channels (number for files) and associated programs (files) from an appropriate source.**"¹

¹ Paper No. 20050329, Examiner's comments, Page 3. Emphasis added.

Claims 1 Through 20

Nowhere does Pond' 690 teach "downloading" of any information, such as the Examiner's "list" "to memory storage hardware." In point of fact, the sole instance of storage occurs, "if the REC button 40 had been activated to implement the one-touch record feature"², and the content resulting from that scenario is the recording of a television program if the program is determined to be a current program³, that is, a television program which is currently being broadcast.

The recording a television program which is currently being broadcast is not what is defined by the foregoing excerpt for Paper No.20050329. Missing from the Examiner's application of Pond '690 is any effort by the Examining staff in Paper No. 20050329 to conform with 37 CFR §1.104(a), (b) and (c) by providing a citation of where Pond '690 provides a written description of:

- (i) a "control unit for ... a list of available channels (number files) and associated programs (files) form an **appropriate source**",
- (ii) a "sub-list created from downloading, to memory storage hardware", or
- (iii) a "sub-list created from downloading" a "list" to "memory storage hardware".

Moreover, Pond '690 is devoid of any teaching or suggestion of how to make or use:

- (iv) a "control unit for ... a list of available channels (number files) and associated programs (files) form an **appropriate source**",
- (v) a "sub-list created from downloading, to memory storage hardware", or
- (vi) a "sub-list created from downloading" a "list" to "memory storage hardware".

² Pond '690, column 8, lines 16 and 17.

³ Pond '690, column 8, line 20.

Accordingly, written clarification in conform with 37 CFR §1.104(a), (b) and (c) in subsequent Office correspondence is respectfully requested.

Not only are neither the Examiner's "list" from a "source" nor the Examiner's "list" from "an appropriate source" identified by Pond '690, but neither any "source" nor any "appropriate source" are identified by Pond '690, and no "control unit" is taught by Pond '690 that has a cap⁴ability to creating a sub-list from a list that has been downloaded. More particularly, in his "open mode" Pond '690 simply states that the sequence of screens appearing in response to manipulation of his "GUIDE" key is simply:

"Normal Viewing → Program Guide TV → Single Channel Guide →
Normal Viewing.⁵

The reason for this mere shift in the video image presented via "conventional television receiver/monitor 22"⁶ is, as explained by Pond '690, that:

"Receiver/descrambler 372 frequency selection for transponder **tuning** and other parameters are controlled by the main CPU 342. The receiver/descrambler 372 is coupled to the main CPU to enable control thereof."⁷

In other words, manipulation of the keys of "remote control unit 18" does nothing in Pond '690 to alter the video display broadcast by "conventional television receiver/monitor 22" except to change

⁴ Pond '690, column 3, line 58.

⁵ Pond '690, column 8, lines 56 and 57.

⁶ Pone '690, column 3, line 58.

⁷ Pond '690, column 11, lines 40-45.

the *tuning* of receiver/descrambler 372.⁸ Missing from this teaching is both a written description and a description of how to make and use the Examiner's "control unit" to "select" and to "create" a "sub-list" from a "list", and how to make and use the Examiner's "control unit" to "create" a "sub-list" from a "list" which has been downloaded "to memory storage hardware." In short, the Examiner's asserted reading of Pond '690 fails to conform to any of the requirements of the first paragraph of 35 U.S.C. §112.

Some recognition should be given to that fact that Pond '690 teaches a visual display of all, or part of a *program screen guide* and its constituent parts such as *channel bar* 54 with "a block of channel names 56,"⁹ and a *grid of program information* 52 on a monitor. Absent from Pond '690 is any effort to comply with the requirements of the first paragraph of 35 U.S.C. §112 to provide a "written description" of that invention in the manner that Pond '690 is now interpreted by the Examiner, and "of the manner and process of making and using it, *in such full, clear, concise, and*

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The variation in the tuning frequency of television receiver/descrambler 16 taught by Pond '690 is a response to remote control unit 18 that is far different from the assertion made by the Examiner, namely that Pond '690 teaches "in column 5, lines 22-40, column 6, lines 3-10, in column 7, lines 21-28, and figures 2 and 5, a **control unit for inputting commands to display a sub-list having a predetermined number of channels (files) with associated programs (files), from the set of all channels (files), the sub-list created from downloading, to memory storage hardware, a list of available channels (number for files) and associated programs (files) from an appropriate source**", and from the other assertion made by the Examiner that Pond '690 teaches "a controller for *creating* one or more sub-lists from the entire list, each sub-list being different from the other sub-lists, and controlling the display unit to successively display each of the sub-lists through the display unit when ever the display command is input through the input unit, Pond teaches, in column 5, lines 22-40, a *creating* [sic, "a creation"] of the pages of the pages from the list of all channels, with all corresponding programs, and the ability to navigate through the different pages, each comprising a different set of elements."

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Pond '690, column 4, lines 61.

exact terms as to enable any person skilled in the art” As a result, all that Pond ‘690 represents is the video presentation of selectable video signals, and lacks teaching of how to use the circuits of his Figures 10 and 11 to make and use the Examiner’s “control unit” to “create” a “sub-list” from a “list”, and how to make and use the Examiner’s “control unit” to “create” a “sub-list” from a “list” which has been downloaded “to memory storage hardware.” There is therefore, no teaching, and thus no anticipation, by Pond ‘690 of how to make and use the circuit taught by Figures 10 and 11 of Pond ‘690 to practice Applicant’s “displaying a sub-list having a predetermined number of files selected in an entire list of files recorded in a recording medium”, because while control unit 18 may be used according to Pond ‘690 to select (*i.e.*, to “tune” conventional television receiver/monitor 22 to) the particular video signal to be displayed on his monitor 22, no teaching is made by Pond ‘690 of how to make control unit 18 alter the field of the video display of monitor 22 to display anything other than the entirety of whatever list is currently being instantaneously represented by a broadcast signal. Moreover, Pond ‘690 provides no “downloading” or “storage” of this *program screen guide* 50. The fact that a video display of a list represented by a broadcast signal may be displayed by the monitor in either its entirety or may be presented as a scrolled image in a series of video frames is irrelevant in view of the language of Applicant’s pending claims because Pond ‘690 lacks a written description of how control unit 18, or any other constituent component of Pond ‘690 may be used to alter any of those video frames.

Moreover, considering claim 1 in its totality, there is, no teaching, and thus no anticipation, by Pond ‘690 of how to make and use the circuit taught by Figures 10 and 11 of Pond ‘690 to practice Applicant’s “displaying a sub-list having a predetermined number of files selected in an

entire list of files recorded in a recording medium”¹⁰ in combination with Applicant’s “controller for *creating* one or more *sub-lists* from the *entire list* ... to *successively display* each of the sub-lists ...”,¹¹ due to the same defects in the specification of Pond ‘690, namely that although control unit 18 may be used according to Pond ‘690 to select the particular video signal to be displayed on his monitor 22, there is no teaching made by Pond ‘690 of how to make control unit 18 alter the field of the video display of monitor 22 to display anything other than the entirety of whatever list is represented by a broadcast signal.

Claim 10

Consideration of Applicant’s claim 10 reveals similar deficiencies, and in particular, any teaching or suggestion of how remote control unit 18 may be used to provide a “*sub-list created from downloading, to memory storage hardware, a list of available channels (number for files), and associated programs, from an appropriate source*” as is asserted by the Examiner.¹² Unexplained by Pond ‘690 is how more than one broadcast signal may be simultaneously recorded.

The Examiner’s application of Pond ‘690 lacks any effort by the Examining staff in Paper No. 20050329 to conform with 37 CFR §1.104(a), (b) and (c) by providing a citation of where Pond

¹⁰ Claim 1, lines 2 and 3.

¹¹ Claim 1, lines 5-7.

¹² Ignored by the Examiner’s interpretation of Pond ‘690 is that Pond ‘690 itself purports to download only one currently broadcast television at a time, and does not purport to record any signals unless those signals are being currently broadcast. See Pond ‘690, column 8, beginning with line 16. Neither lists, sub-lists nor “associated programs” are recorded.

‘690 provides a written description of:

- (i) how a “*sub-list*” could possibly be “*created from downloading, to memory storage hardware, a list of available channels (number for files), and associated programs*” as is asserted by the Examiner;
- (ii) how “*a list of available channels (number for files), and associated programs*” could be downloaded “*from an appropriate source*” as is asserted by the Examiner, when Pond ‘690 itself teaches recording of a single, currently broadcast program; and
- (iii) precisely where Pond ‘690 teaches how to create “*the sub-list having a predetermined number of channels (files) each with associated programs (files), from the set of all channels (files) and associated programs (files)*” as is asserted by the Examiner.¹³

Written clarification in conform with 37 CFR §1.104(a), (b) and (c) in subsequent Office correspondence is respectfully requested.

Claim 14

Turning to Applicant’s claim 14, the Examiner asserts that Pond ‘690 teaches:

“a method of [*sic, “for”*] controlling a file list display apparatus having a *plurality of files of data* recorded on a vast-capacity recording medium ... [by] detecting all [*sic, “of”*] the files recorded ... and storing a list of the detected files in a storage unit separate from the vast-capacity recording medium”¹⁴

¹³ Asserted by the Examining staff in Paper No. 200500329, page 6.

¹⁴ Paper No. 20050329, page 7.

This is a gross distortion of Pond '690, which discloses but a single video cassette recorder 20,¹⁵ and nowhere provides a written description, let alone a description of how to make and use "a storage unit separate from the vast-capacity recording medium", or either assembling or "controlling a file list display apparatus having a *plurality of files of data* recorded"; moreover, nowhere does Pond '690 contemplate on a vast-capacity recording medium ... [by] detecting all [*sic*, "of"] the files recorded ... and storing a list of the detected files in a storage unit separate from the vast-capacity recording medium"

Missing from the Examiner's application of Pond '690 is any effort by the Examining staff in Paper No. 20050329 to conform with 37 CFR §1.104(a), (b) and (c) by providing a citation of where Pond '690 provides a written description of:

- (i) a "control unit" for "controlling a file list display apparatus having a *plurality of files of data* recorded",
- (ii) a "control unit" for "detecting all [*sic*, "of"] the files recorded", and
- (iii) a "control unit" and a second "storage unit" for "storing a list of the detected files in a storage unit separate from the vast-capacity recording medium".

Written clarification in conform with 37 CFR §1.104(a), (b) and (c) in subsequent Office correspondence is respectfully requested.

In summary, and ignoring *arguendo* that Pond '690 is deficient in its compliance with the

¹⁵ This is but another example of the misrepresentation of Pond '690 set forth in Paper No. 20050325. Moreover, Pond '690 expressly disclaims the Examiner's interpretation, and states that the practice of his system "does not require a video recorder for operation." Column 3, line 59.

several requirements of the first paragraph of 35 U.S.C. §112, Pond '690 is devoid of both a written description and any description "of the manner and process of making and using it, *in such full, clear, concise, and exact terms* as to enable any person skilled in the art" Consequently, Pond '690 fails to anticipate the pending claims 1 through 20, and this rejection must be withdrawn.

2. The representation of Pond '690 set forth in Paper No. 20050329 is inconsistent with the express teachings of Pond '690.

In support of the rejection, the Examiner asserts that Pond '690 teaches:

(i) "in column 5, lines 22-40, column 6, lines 3-10, in column 7, lines 21-28, and figures 2 and 5, a control unit for inputting commands to display a sub-list having a predetermined number of channels (files) with associated programs (files), from the set of all channels (files), the sub-list created from downloading, to memory storage hardware, a list of available channels (number for files) and associated programs (files) from an appropriate source."¹⁶

What Paper No. 20050329 asserts is that each numerical symbol or icon representing a "channel" constitutes a distinct "file" as that noun is used in Applicant's claim 1. Contrary to the Examiner's assertion however, is the fact that Pond '690 itself expressly teaches that all images formed on monitor 22 are raster scans which have long been known in both the art and in the United States Patent & Trademark as "fields", such as those provided by satellite system band, video cassette recorder helical scans of a cassette tape, or atmospheric television broadcast signals, all of which are time varying fields of raster scans. The art of broadcasting television schedules is better shown by U.S. Patent No. 5,479,268 to Patrick Young et al. Even the logo 60 of the current channel displayed

¹⁶ Paper No. 20050329, Examiner's comments, Page 3.

at the top of channel bar is a result of a raster scan, rather than an image retrieved from a “file.”

If the Examiner’s assertion that each broadcast channel constitutes a “file”, then what is the art recognized difference between a “field” and a “frame” in a broadcast television signal? The Examiner’s attention is invited to consider the definition of “file” set forth in the Microsoft *Computer Dictionary*, (5th Ed. 2002), namely:

“[a] complete, named collection of information, such as a program, a set of data used by a program, or a user created document. A file is the basic unit of storage that *enables a computer to distinguish one set of information from another*. A file is the “glue” that binds a conglomeration of instructions, numbers, words, or images into a coherent unit that a user can retrieve, change, delete, save, or send to an output device.”

Nowhere does Pond ‘690 explain how he enables his system to store currently broadcast television programs and then enable his control unit “storage that *enables a computer to distinguish one set of information from another*.” In summary, the currently broadcast signals stored by Pond ‘690 lack all of these attributes, aspects, characteristics and features of a file, and concomitantly the control unit of Pond ‘690 is devoid of both a written description and a teaching of how to make or use his control unit to “change, delete, save, or send to an output device” those currently broadcast television programs which have been recorded.

This is a glaring deficiency in the Examiner’s interpretation of Pond ‘690. Written clarification in conform with 37 CFR §1.104(a), (b) and (c) in subsequent Office correspondence is respectfully requested.

In contradistinction to the Examiner’s inaccurate characterization of Pond ‘690, Applicant defines “input unit” that initiates display of a sub-list, with the sub-list “having a predetermined

number of files **selected** in an entire list of the files" As explained by Pond '690, in one aspect of the "page" mode,

"the up and down arrows will display only a **selected** subset of the available channels (i.e., ten (10) channels at that time) and the *program screen guide* includes a page bar for identifying the presence of any selectable program channels that are not present on the currently displayed channel bar."¹⁷

This excerpt from Pond '690 is a statement about the limitations of the visual display, and is not a statement about the *program screen guide* and its constituent parts such as *channel bar 54*, common to both the "open mode" and the "closed mode" of his operation. Moreover, these "available channels" constitute "a block of channel names 56,"¹⁸ devoid of content or other information. What the Examiner has endeavored to identify as "files" is simply "a block of channel names 56 ... with the current channel 58 ... being highlighted [and t]he logo 60 of the current channel [being] displayed at the top of the channel bar 54 and the number 62 of the current or selected channel [being] displayed at the bottom."¹⁹ This "information" is simply "the channel bar 54" component of a single video visual display supplementing a "program information grid 52 [that] can include information relating to the program title, day, time of day, starts-stop time of the program, rating of the program, data services available and parental lock setting."²⁰ As explained by Pond '690, the "open mode" program guide displays the entire "on-screen programming guide" comprised of the "grid of program

¹⁷ Pond '690, column 5, lines 27, 31.

¹⁸ Pond '690, column 4, lines 61.

¹⁹ Pond '690, column 4, lines 60-66.

²⁰ Pond '690, column 4, lines 56-60.

information illustrated by dashed box 52 and a program bar or channel bar illustrated by dashed box 54", while in the "closed mode" only "channel bar 54 is displayed", as illustrated in the figure 3 and 4 respectively. In short, what the Examining staff has endeavored to identify as a "file" is nothing more than a time variant broadcast signal which represents a single *program screen guide* with its constituent parts such as *channel bar 54* and *grid of program information 52*.²¹ Moreover, the *channel bar 54* is constant, is arranged in sequential order that is not alterable by remote control unit 18, regardless of whether the monitor is placed in its *direct channel entry mode*²² or in its *page mode*.²³ Consequently, the entire "on-screen programming guide" taught by Ponds '690 is devoid of any "sub-list"; the mere fact that monitor 22 of Pond '690 is incapable of displaying the entire "on-screen programming guide" within a single frame, but instead must "scroll through"²⁴ a sequentially array of numerically ordered channels does not convert the entire "on-screen programming guide" into "sub-files." Even ignoring *arguendo* that the "on-screen programming guide" of Ponds '690 lacks any of the characteristics, attributes and alterability of a "file", the "on-screen programming guide" of Ponds '690 is disclosed as a single unalterable field written in the singular number, rather than in the plural number of Applicant's "entire list of files" Absent teaching of this, Pond '690 fails to present a *prima facie* showing of anticipation under 35 U.S.C. §102(b), and this rejection must be withdrawn.

²¹ Pond '690, column 4, lines 61.

²² Pond '690, column 4, lines 61.

²³ Pond '690, column 5, line 56.

²⁴ Pond '690, column 5, line 9.

3. The express teachings of Pond '690 contradict the interpretation by the Examining staff set forth in Paper No. 20050329, and fail to make a *prima facie* showing of anticipation "the invention" defined by pending Claims 1-20

The statement in Paper No. 20050329 that,

(i) “in column 5, lines 22-40, column 6, lines 3-10, in column 7, lines 21-28, and figures 2 and 5, a control unit for inputting commands to display a sub-list having a predetermined number of channels (files) with associated programs (files), from the set of all channels (files), the sub-list *created* from downloading, to memory storage hardware ...”,²⁵

is fantasy, unsupported by the record of this application. During these two distinctive “open” and “closed” modes of Pond ‘690, *remote control unit* 18 enables the user to “scroll through the available channels”,²⁶ but nowhere does Pond ‘690 teach that remote control unit 18 is enabled to input Applicant’s “display command for displaying a sub-list having a predetermined number of files *selected* in an entire list”; to the contrary, in both its “open mode” and its “closed mode”, as well as in its “direct channel mode” and in its “page mode”, *remote control unit* 18 of Pond ‘690 simply scrolls through a single “on-screen programming guide”. In point of fact, *remote control unit* 18 lacks any key which enables a user to anything other than view whatever video signal is currently being broadcast, regardless of whether than video signal represents the “on-screen programming guide” or a television program. Simply put, “remote control unit 18” of Pond ‘690 merely changes the tuning of monitor 22, and enables the user to scroll through the video image appearing on the screen of monitor 22; unlike the practice available under Applicant’s claims, with Pond ‘690 a user is not able to “select” any “file” from the past, such as a file which the viewer had viewed thirty-five

²⁵ Paper No. 20050329, Examiner’s comments, Page 3.

²⁶ Pond ‘690, Column 6, line 19.

minutes previously, because the files are time varying broadcast signals. Without this feature, Pond ‘690 makes no anticipation of Applicant’s claims and this rejection may not be maintained.

Pond ‘690 is singularly devoid of a selection of files from “an entire list of the files recorded in recording medium” simply because Pond ‘690 lacks teaching or suggestion of any recording medium. What Pond ‘690 teaches however, is a serial illustration of “on-screen programing guide”²⁷ taken from an on-air broadcast signal by tuning the resonant frequency of television receiver/descrambler 16 to receive the corresponding to video images displayed either the open or closed modes, and relies upon remote control unit 18 to “scroll through” the entirety of those images, absent any selection of “files” or creation of any “sub-list(s)” from those “files.” The inconsistency of the Examiner’s interpretation of Pond ‘690 is better illustrated by the Examiner’s subsequent assertion that Pond ‘690 teaches:

- (ii) “a controller for creating one or more sub-lists from the entire list, each sub-list being different from the other sub-lists, and controlling the display unit to successively display each of the sub-lists through the display unit whenever the display command is input through the input unit, Pond teaches, in column 5, lines 22-40, a creating of the pages of the pages from the list of all channels, with all corresponding programs, and the ability to navigate through the different pages, each comprising a different set of elements.”²⁸

The fallacy in this excerpt from Paper No. 20050329 is that nowhere does Pond ‘690 disclose a “controller” distinct from the “input unit”, and nowhere does Pond ‘690 suggest Applicant’s “controller” that enables a user “to navigate through the different pages” as disingenuously asserted by Paper No. 20050329.

²⁷ Pond ‘690, Column 4, line 40.

²⁸ Paper No. 20050329.

4. **As interpreted by Paper No. 20050329, Pond '690 fails to anticipate "the invention" defined by pending Claims 1-20**

35 U.S.C. §102(b) mandates consideration of "the invention" defined by the pending claims.

Here, Paper No. 20050329 merely paraphrases, and thus impermissibly distorts that express language of claims 1 through 20. Moreover, Pond et al. (*hereafter* : Pond) fails to anticipate the claims as originally filed and further fails to anticipate the claims as amended, the amendment being made in view of the objections raised in paragraphs 1 and 2 on page 2 of the Office action.

Note that in order for an anticipation rejection to be proper, the anticipating reference must disclose exactly what is claimed. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Note here that the Examiner has not relied on "inherency," accordingly, each and every element must be expressly described in Pond.

Claim 1

Claims 1, for example, calls for *an input unit for inputting a display command for displaying a sub-list having a predetermined number of files selected in an entire list of the files recorded in a recording medium.*

Here, the Examiner refers to Pond's col. 5, lines 22-40, Fig. 2 and Fig. 5. Note also that the Examiner erroneously equates Pond's "channels" with the claimed *files*.

Col. 5, lines 22-40 state: "Under another selected embodiment of the present invention,

remote control unit 18 includes PAGE key 40 can be used to display a screen that allows the user to "page" forward, backward, up and down through various screens in a "page" mode. According to one aspect of the "page" mode, the up and down arrow keys will display only a selected subset of the available channels (i.e., ten (10) channels at a time) and the program screen guide includes a page bar for identifying the presence of any selectable program channels that are not present on the currently displayed channel bar. According to a separate aspect of the "page" mode when it is used while in the "Open Mode," the left and right arrow keys advance by a predetermined time interval (i.e., one day intervals) the portion of the available program schedule information that is displayed and the program screen guide includes a page bar for identifying the presence of any time-dependent program information for the program channels that is not presently shown on the program screen guide."

A review of the foregoing finds no mention of *an entire list of the files recorded in a recording medium*, and the Examiner has failed to identify where *a recording medium* is disclosed in Pond for recording Pond's "channels."

Claim 14

Looking further into the rejection, we find that the Examiner, on page 6, paragraph 16, with respect to claim 14, refers to Pond's ROM as the means for storing the *entire list* and further refers to Pond's RAM. We will address claim 14 later. As for now, we look back to claim 1 and read into the rejection reference to Pond's ROM or RAM as the claimed *recording medium*. The Examiner has made no mention of any other recording medium.

Looking to Pond's disclosure, we find, with respect to Fig. 10, the disclosed ROM and RAM.

Pond discloses "The main CPU 342 controls the overall operation of the IRD 16 by executing object code software stored in the read only memory (ROM) 351 and by both writing and reading data to and from the random access memory (RAM) 348." See col. 11, lines 17-20.

Accordingly, ROM 351 stores only "object code software;" and being a read only memory can not store the "channel" information disclosed in Pond. That leaves us with RAM 348 to consider. Looking further to Pond's disclosure, we find no other mention of RAM 348 nor to what type of "data" that is stored therein.

Deficiencies in the factual basis cannot be supplied by resorting to speculation or unsupported generalities. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967) and *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970).

Accordingly, the rejection of claim 1 is in error, because Pond fails to disclose, and thus anticipate, at least the claimed *entire list of the files recorded in a recording medium*. Thus the rejection should be withdrawn.

Looking again to the written rejection of claim 1, the Examiner states that Pond "teaches", instead of Pond discloses. A §102 rejection must be based on disclosure.

"There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 18 USPQ2d 1896 (Fed. Cir. 1991).

The Examiner further states that Pond teaches a "sub-list created from downloading, to memory storage hardware, a list of available channels . . . and associated programs . . . from an

appropriate source." We note that the Examiner's arguments (page 10 paragraph 30) in response to the Applicant's traversal are not too different from the language used in the written rejection.

It is respectfully requested that the Examiner identify where this **memory storage hardware** is **disclosed** in Pond. The Examiner is further requested to identify where Pond discloses **an appropriate source**.

On page 10, paragraph 30, the Examiner goes on to state,

"Pond teaches the entire list stored [at] a remote location and portions of the entire list being downloaded, as needed, to memory at the users receiver."

The Examiner uses nearly identical language in paragraph 32.

It is well known in the art, see U.S. Patent No. 5,479,268 to Patrick Young et al. incorporated by reference in Pond, that a broadcast source provides schedule information on the vertical blanking interval (VBI) of a broadcast video signal. A detector/decoder separates this information and processes it for display in response to a request by a user (viewer), otherwise it remains on the VBI and is ignored by the television system.

The schedule information is a single file, not a plurality of files, containing data pertaining to every channel available from the broadcast source (such as a local television company like Comcast or Cox). That is, the information is **not** broken down into a plurality of files with each file being sent on a separate VBI.

The schedule information is decoded and displayed in response to the user request (e.g., displayed in the formats disclosed by Pond).

Young et al. discloses:

In the system 180, programmable tuner 202, which may be part of a cable decoder unit, receives a TV signal from antenna 200 and/or from cable input 205. Tuner output 216 goes to a vertical blanking interval (VBI) decoder 222, which may be a closed caption decoder or a high speed teletext decoder. **Listing** information and other support information, such as cable channel assignment data, will be transmitted over the VBI by one or more local stations or cable channels several times a day or continuously.

When update is required, programmable tuner 202 will be tuned automatically to the station or cable channel carrying the data. After the VBI signal is processed by CPU 228, the **listing** data is stored in schedule memory 232.

For a What's on TV request, **the listing** stored in schedule memory 232 is retrieved, processed by CPU 228, and outputted to video display generator 224. Video switcher 226 is enabled by CPU output 246 to select the video display generator 224 output whenever schedule data is to be presented to the TV/monitor 210.

The listing is **not** a plurality of files, but is instead a single file, similar to the file saved used to generate the Examiner's rejection. Consider the rejection. The file data, once recalled by the Examiner, is decoded by a word processor and displayed on a screen. If the information is formatted in such a way as being unable to display the entire file on a screen, the information is separated into display pages. Accordingly, the screen display may show, for example, part of a page, a whole page or two whole pages. These pages are **not** separate files, and are not a sub-list of plural files.

Likewise, in Pond, the channel information is part of a single file located on the VBI of a video signal, decoded and stored in a schedule memory. If the information is formatted in such a way as being unable to display the entire schedule on a screen, the schedule is separated in display pages.

Pond discloses:

As shown in FIGS. 5 and 6, the "Page Mode" can be used when the program

guide screen 50 is in "Open Mode," and can also be used when the program guide screen 51 is in "Closed Mode." According to one embodiment of the present invention, when the program guide is in "Page Mode," the program guide screen 70 includes a page bar 72 as shown in FIG. 5. According to a separate embodiment of the present invention in which the guide screen is in "Open Mode," the program guide screen 70 includes a page bar 71 for indicating the presence of any program channel information (such as time-dependent program information) that is not shown on the currently displayed program screen guide. As will be appreciated by those skilled in the art, the page bars 71, 72 visually convey to the user information about the position of the currently displayed page relative to the total pages available for viewing. For example, a vertical bar along the side of the program guide screen may include a segment that is highlighted or otherwise visually distinct from the remainder of the bar, and the position of this highlighted portion relative to the remainder of the bar indicates how many additional pages of channel information are available for viewing. Alternatively, the page bar 72 may provide an alphanumeric indication of which page is being viewed (i.e., "page 1 of 6" or "1/6"). As shown in connection with FIG. 6, a page bar 72 can also be used in connection with the "Closed Mode" operation to provide a visual or alphanumeric indication next to the channel bar 54.

There is no disclosure supporting any holding that these pages are separate files, nor is there any disclosure supporting any holding that each channel is stored in memory as separate or individual files.

The Examiner repeatedly refers to Pond's col. 5, lines 22-40; col. 6, lines 3-10, col. 7, lines 21-28 and Figs. 2 and 5.

Col. 5, lines 22-40 refer to the paging operation controlled by a remote control.

Col. 6, lines 3-10 refer to the determination of available channels from a broadcast source.

Such determination is well known in the art. When a user purchases a new television and connects it to a tv cable input from a broadcast source (such as Comcast or Cox), there is a menu option to automatically detect available channels in order to set up the receiver's tuner. If the tuner can receive

124 channels, but there are only 99 channels available that contain video information, the automatic setup blocks the use of channels that do not carry video. Accordingly, if channels 100-124 are blocked then when a user of a remote scrolling through the channels reaches 99, the next channel to be displayed in response to a channel up command will start again at 1, skipping channels 100-124.

Col. 7, lines 21-28 discuss "any required memory hardware" and where such hardware may be located.

None of the sections of Pond referred to by the Examiner, *displaying a sub-list having a predetermined number of files selected in an entire list of the files recorded in a recording medium; nor creating one or more sub-lists from the entire list, each sub-list being different from the other sub-lists, and controlling the display unit to successively display each of the sub-lists through the display unit whenever the display command is input through the input unit.*

Accordingly, the rejection is deemed to be in error and should be withdrawn.

Claim 10

With respect to claim 10, it is required that Pond disclose a step of *reading an entire list of files recorded in a recording medium*. We find no factual reference to such a step being disclosed in Pond the rejection. The Examiner repeats the Applicant's claim language, identifies a portion of Pond's disclosure, *i.e.*, col. 5, lines 22-40, but fails to show where the above step is found in that portion of Pond's disclosure. Instead, the Examiner refers to a "control unit for inputting commands to display a sub-list, from the list of available channels." There is no indication that this "list of available channels" is entirely read, nor that this list is recorded in a recording medium.

Accordingly, the rejection of claim 10 is in error and should be withdrawn.

Claim 14

With respect to claim 14, it is required that Pond disclose *detecting all the files recorded on said vast-capacity recording medium.*

The Examiner equated Pond's ROM 351 with the claimed *vast-capacity recording medium.*

We can find no disclosure in Pond that ROM 351 stores Pond's entire list of available channels, and the Examiner has not pointed to any location in Pond supporting the rejection. Note, *Ex parte Levy*, 17 USPQ2d 1461, 1462 (1990) states:

"it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference."

We can only find that object code software is stored in the read only memory (ROM) 351.

Claim 14 also calls for *storing a list of said detected files in a storage unit separate from the vast-capacity recording medium.* Here, it appears that the Examiner is equating Pond's RAM 348 with the claimed *storage unit.* However, we can find no disclosure in Pond indicating that a list of files detected in ROM 351 is stored in RAM 348.

In Pond's only reference to RAM 348, Pond discloses "The main CPU 342 controls the overall operation of the IRD 16 by executing object code software stored in the read only memory (ROM) 351 and by both writing and reading data to and from the random access memory (RAM) 348." See col. 11, lines 17-20. There is no disclosure as to what the term "data" represents. Deficiencies in the factual basis cannot be supplied by resorting to speculation or unsupported generalities.

Accordingly, the rejection of claim 14 is deemed to be in error and should be withdrawn.

Having shown that claims 1, 10 and 14 are not anticipated by Pond, it is thus deemed that the rejection of claims 2-9, 11-13 and 15-19 is also deemed to be in error and should be withdrawn.

C. Claim 20 was rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Pond in view of van Zoest et al. (US 6,496,802) (hereafter : Zoest). The Applicant respectfully traverses this rejection for the following reason(s).

Claim 20 requires that *said files contain music data and are grouped according to a one of a song title, an album a song came from, an artist who did the song or a song's genre.*

The Examiner erroneously states that Pond teaches "the files consist of entertainment data," and refers us to Pond's col. 4, lines 5-8. Looking to the cited section of Pond we find disclosed therein:

VCR, AUX and TV in the control block illustrated by reference numeral 30. These various modes of operation allow a single remote control unit to operate a multiplicity of entertainment equipment. In each of the modes . . .

We find no mention of the word "files," nor the term "entertainment data" in the cited section of Pond. A search of Pond's disclosure finds no mention of the word "files," nor the term "entertainment data." It is the job of all PTO examiner's to present factual evidence, not make up terms to suit his or her need to make a rejection.

On page 11, paragraphs 33 and 34, the Examiner states that "the terms 'file' or 'entertainment data' are logical equivalents for **ideas taught** by the Pond reference." (emphasis added).

Maybe that is what the Examiner gets from Pond, but one of ordinary skill in the art would not equate files to channels, and would not equate channel information to entertainment data.

Additionally, Pond is directed to television and in particular an on-screen guide of television channels. One of ordinary skill in the art would have no motivation to look to Zoest's teachings of *music data* for modifying Pond or even combining the teachings of Pond and Zoest.

The Examiner fails to point out why one of ordinary skill in the art would look to a teaching concerning *music data* in order to modify Pond. Instead, the Examiner refers to Zoest's teaching of separating a list into sub-lists if it comprises more than 250 elements. The Examiner has not identified where pond discloses a list having more than 250 elements, such that one of ordinary skill in the art, if familiar with Zoest, would look to the teachings of Zoest to modify Pond. And it is not clear how one of ordinary skill in the art of television broadcasting would be familiar with Zoest.

Accordingly, the rejection of claim 20 is deemed to be in error and should be withdrawn.

D. Paper No. 20050329 Is Incomplete Under 37 CFR §1.104(a), (b) and (c).

As noted in the foregoing paragraphs, Paper No. 20050329 is incomplete under 37 CFR §1.104(a), (b) and (c); clarification is respectfully requested in subsequent Office correspondence on the following issues, by specifically stating:

- (i) precisely where Pond '690 teaches a "controller" that is distinct from the "input unit."
- (ii) precisely where Pond '690 teaches Applicant's "controller" that enables a user "to navigate through the different pages."
- (iii) precisely where Pond '690 teaches how the keys of *remote control unit* 18 may be manipulated "for creating one or more sub-lists from an entire list, with each sub-list being different from the other sub-lists."
- (iv) precisely where Pond '690 teaches how the keys of *remote control unit* 18 may be manipulated to "create one or more sub-lists from an entire list, with each sub-list being different from the other sub-lists, and control the display unit to successively display each of the sub-lists."
- (v) precisely what is the art recognized difference between a "file" and a "frame" of a raster scanned image, and what is the art recognized difference between a "file" and a "field" of a raster scanned image?
- (vi) where in the record of this application is an equivalence established between Applicant's "file" and a "frame" of a raster scanned image, and where in the record of this application is an equivalence established between Applicant's "file" and a

“field” of a raster scanned image?

- (vii) precisely where Pond ‘690 teaches a “control unit for ... a list of available channels (number files) and associated programs (files) form an **appropriate source**”;
- (viii) precisely where Pond ‘690 teaches a “**sub-list created from downloading, to memory storage hardware**”, or
- (ix) precisely where Pond ‘690 teaches a “**sub-list created from downloading**” a “list” to “**memory storage hardware**”.
- (x) precisely where Pond ‘690 teaches how to make or use a “control unit for ... a list of available channels (number files) and associated programs (files) form an **appropriate source**”,
- (xi) precisely where Pond ‘690 teaches how to make or use a “**sub-list created from downloading, to memory storage hardware**”, or
- (xii) precisely where Pond ‘690 teaches how to make or use a “**sub-list created from downloading**” a “list” to “**memory storage hardware**”.
- (xiii) how a “*sub-list*” could possibly be “*created from downloading, to memory storage hardware, a list of available channels (number for files), and associated programs*” as is asserted by the Examiner;
- (xiv) how “*a list of available channels (number for files), and associated programs*” could be downloaded “*from an appropriate source*” as is asserted by the Examiner, when Pond ‘690 itself teaches recording of a single, currently broadcast program; and
- (xv) precisely where Pond ‘690 teaches how to create “the sub-list heaving a

predetermined number of channels (files) each with associated programs (files), from the set of all channels (files) and associated programs (files)” as is asserted by the Examiner.²⁹

- (xvi) precisely where Pond ‘690 teaches how to make or use a “control unit” for “controlling a file list display apparatus having a *plurality of files of data* recorded”,
- (xvii) precisely where Pond ‘690 teaches how to make or use a “control unit” for “detecting all [*sic*, “of”] the files recorded”, and
- (xviii) precisely where Pond ‘690 teaches how to make or use a “control unit” and a second “storage unit” for “storing a list of the detected files in a storage unit separate from the vast-capacity recording medium”.

The Examiner is respectfully requested to reconsider the application, withdraw the objections and/or rejections and pass the application to issue in view of the above amendments and/or remarks.

²⁹

Asserted by the Examining staff in Paper No. 200500329, page 6.

Should a Petition for extension of time be required with the filing of this Amendment, the Commissioner is kindly requested to treat this paragraph as such a request and is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of the incurred fee if, **and only if**, a petition for extension of time be required **and** a check of the requisite amount is not enclosed.

A petition for a one month extension of time accompanies this response. The Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of \$120.00. Should the petition become lost, the Commissioner is requested to treat this paragraph as a petition for an extension of time.

Respectfully submitted,



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